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EXAMINER

MISIASZEK, MICHAEL

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3625

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/697,485
Filing Date: October 30, 2003
Appellant(s): STASHLUK ET AL.

Jenni R. Moen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/26/2007 appealing from the Office action mailed 1/5/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6536659	Hauser et al.	3-2003
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2004/0172260	Junger et al.	9-2004
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"Cattron acquires Theimeg"; Modern Material Handling, Boston; October 2000

"J. Crew Selects Newgistics ReturnValet for Managing Product Returns", Business
Editors, Business Wire; January 14, 2002

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 33, and 34, and 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser (US 6,536,659 B1) in view of "Cattron acquires Theimeg"; Modern Material Handling, Boston; Oct 2000 and Junger et al. (US 20040172260 A1)

Claims 4 – 6 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of "Cattron acquires Theimeg" and Junger et al., as applied to claims 3 and 34 above, and further in view of "J. Crew Selects Newgistics ReturnValet Service for Managing Product Returns", Business Editors, Business Wire; Jan 14, 2002.

A copy of the rejections, as set forth in the Final Office Action, appears in Appendix A.

(10) Response to Argument

On page 12 of the brief, Appellant argues that there must be some teaching, suggestion, or motivation to combine prior art references. *KSR* forecloses appellant's argument that a specific teaching is required for a finding of obviousness. In addition, the combinations recited only unite elements of the prior art references, as detailed in the previous rejection, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

On pages 20-21 of the brief, Appellant argues that the combination of references does not disclose a printed label including a destination address of one of a plurality of regional return centers. While none of the references alone teaches the specific feature, Hauser teaches a printed label with a return address (see at least abstract) as noted in the previous rejection, and the ReturnValet1 ("Cattron acquires Theimeg") reference teaches a plurality of regional return centers. Combining these two features, without any change in their respective functions, would have yielded the predictable result of a printed label with a destination address of a regional return center. The Examiner notes that the disclosure in ReturnValet1 that a consumer "**can** go and return the product" (emphasis added) does not discredit the mailing of a product.

On pages 22-23 of the brief, Appellant argues that there is no teaching, suggestion, or motivation to combine Hauser, Junger, and ReturnValet1. As a preliminary matter, motivations were cited in the previous rejections. Regardless, *KSR* forecloses appellant's argument that a specific teaching is required for a finding of obviousness. In addition, the combinations recited only unite elements of the prior art references, as detailed in the previous rejection, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

On pages 24 of the brief, Appellant argues that certain dependent claims are patentable based on their dependence on the independent claims previously argued. Accordingly, the Examiner directs Appellant to the remarks above concerning the independent claims.

On page 25 of the brief, Appellant argues that the cited references do not disclose certain features of the claimed invention. However, these arguments merely amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant has simply cited a portion of the reference and concluded that, based on the citation, the reference does not disclose the claimed invention. Appellant has provided no reasons **why** the cited reference does not disclose the claimed feature.

On page 26 of the brief, Appellant argues that the proposed combination does not disclose the claimed invention because the limitations "wherein the purchase transaction is represented by a customer number" and "wherein the purchase transaction is represented by a product number" were given little patentable weight by the Examiner. Appellant contends that the examiner has not properly considered each aspect of the claimed invention. However, the Examiner asserts that the various numbers that are claimed to represent the transaction are merely non-functional descriptive material. The positively recited steps would be performed in the same manner regardless of how the numbers that represent the purchase transaction are labeled. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.2d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to label the numbers using any convention because such information does not functionally relate to the steps in the method claimed and merely labeling the numbers differently from that in the prior art would have been obvious. See *Gulack* cited above.

On pages 27-30 of the brief, Appellant argues that the cited combination of references is improper because there is no teaching, suggestion, or motivation to combine the cited prior art references. As a preliminary matter, motivations were cited in the previous rejections. Regardless, *KSR* forecloses appellant's argument that a specific teaching is required for a finding of obviousness. In addition, the combinations recited only unite elements of the prior art references, as detailed in the previous rejection, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Michael A. Misiaszek

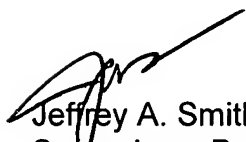
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Supervisory Patent Examiner
Art Unit 3625

APPENDIX A

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3, 33, and 34, and 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser (US 6,536,659 B1) in view of "Cattron acquires Theimeg"; Modern Material Handling, Boston; Oct 2000 and hereafter referred to as "ReturnValet 1" and Junger et al. (US 20040172260 A1, hereinafter Junger)

Regarding Claims 1, 33

Hauser discloses a method, performed by a returns provider, handling customer returns of items on behalf of multiple merchants, comprising the steps of:

- storing a set of merchant returns rules in a processing system, such that a set of returns rules is associated with each merchant (see at least Abstract and Col 8, lines 23 – 54 and Figures 1 and 2),
- receiving packages containing returned items at a returns center (see at least Figure 1);
- wherein affixed to each package is a printed label, the label having machine readable data representing at least the identification of a merchant associated with the returned item (see at least Abstract);
- scanning the machine readable data on each package (see at least Col 8, lines 23 – 54);

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- correlating at least a portion of the machine readable data with a set of returns rules (see at least Col 6, lines 6, lines 37 – 42, Col 8, lines 23 – 54);
- notifying the merchant of a returned package, based on the results of the correlating step (see at least Col 2, lines 49 – 67).

Hauser does not disclose:

- maintaining a plurality of regional return centers
- receiving packages by carrier delivery at a selected regional return center
- the printed label including a destination address associated with the selected one of the regional returns centers, the selected one of the regional returns centers selected for carrier delivery of the package because the selected one of the regional returns centers is geographically closer to a location of a customer from which the package is received than others of the plurality of regional returns centers

ReturnValet 1 teaches that it is known to include maintaining a plurality of regional return centers (at least page 1: 4000 postal centers) and returning a package v to a regional return center closest to the customer returning the package (at least page 1: customer returns product to nearest postal center) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Hauser with the maintaining a plurality of regional return centers and returning to the station closest to the customer of ReturnValet 1, since such a

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modification would have provided a decrease in effort and an increase in return efficiency via a means for a customer to receive instant credit for a returned item (see at least page 1 of ReturnValet 1).

Junger teaches that it is known to include receiving a package via carrier delivery of returned items at a return center (at least paragraph [0181]: shipper picks up return items from customer) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Hauser with the carrier delivery, as taught by Junger, since such a modification would have provided a further simplified return process for a customer (at least paragraph [0181] of Junger).

Regarding Claims 3, 34

Hauser discloses:

- the machine-readable data further identifies a purchase transaction (Figure 2).

Regarding Claims 39, 46

Hauser discloses:

- notifying a merchant associated with the at least one returned item of the receipt of the package at the selected regional returns center (at least column 7, lines 30-38: merchant tracks status of returns)
- the machine readable data identifies a merchant associated with the at least one returned item, and wherein the set of returns rules to be used in the processing

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of the at least one returned item is associated with the merchant (at least column 8, lines 23-54 coded rules associated with merchant)

Regarding Claims 38, 40, 41

Hauser discloses the claimed invention except for:

- notifying the customer of the receipt of the package at the selected regional return center
- providing tracking information to the customer
- the printed carrier label includes a visual flag that is human readable, the visual flag indicative of a final package destination other than the selected regional returns center

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Junger teaches that it is known to include providing the customer with updated tracking information regarding a returned product (at least paragraph [0180]: update tracking information for customer) and to indicate the final destination of a returns package on a printed label readable by a human (at least figure 11A: final package destination of Nintendo) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Hauser with the tracking and label information, as taught by Junger, since such a modification would have provided a further simplified return process for a customer (at least paragraph [0181] of Junger).

Regarding Claims 42-45

Hauser discloses:

- determining the location of the customer associated with the package (at least column 14, lines 1-15: address of customer obtained)
- providing the printed carrier label to the customer (at least abstract: label provided to customer)
- determining a postal code of the customer (at least column 14, lines 1-15: address of customer obtained)

Hauser does not disclose:

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- determining that the selected one of the regional returns centers is geographically closer to the location of the customer than locations of others of the plurality of regional returns centers
- the selected regional returns center comprises a carrier station nearest the customer
- the selected regional returns center is associated with the returns provider

ReturnValet 1 teaches that it is known to include determining and selecting a regional return center associated with the returns provider closest to a customer (at least page 1: nearest postal center associated with ReturnValet determined) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Hauser with determining a station associated with the returns provider closest to the customer of ReturnValet 1, since such a modification would have provided a decrease in effort and an increase in return efficiency via a means for a customer to receive instant credit for a returned item (see at least page 1 of ReturnValet 1).

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2. Claims 4 – 6 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of ReturnValet 1 and Junger as applied to claims 3 and 34 above, and further in view of “J. Crew Selects Newgistics ReturnValet Service for Managing Product Returns”, Business Editors, Business Wire; Jan 14, 2002 and hereafter referred to as “ReturnValet 2”.

Hauser, ReturnValet1 and Junger disclose the claimed invention except for:

- the purchase transaction is represented by an invoice number
- the purchase transaction is represented by a customer number
- the purchase transaction is represented by a product number

Regarding Claim 4, 35

ReturnValet 2 teaches that it is known to include the purchase transaction is represented by an invoice number (Page 2).

Regarding claims 5, 6, 36, 37

The recitations that “wherein the purchase transaction is represented by a customer number” and “wherein the purchase transaction is represented by a product number” are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “invoice number” already disclosed by ReturnValet 2.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Hauser with representing a purchase transaction with an invoice number, as taught by ReturnValet 2, since such a modification would have expedited the returns process (see at least page 2 of ReturnValet 2).